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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/078,059	02/20/2002	Steven M. Ruben	PF466P2	6326
22195	7590	12/24/2003	EXAMINER	
HUMAN GENOME SCIENCES INC			O HARA, EILEEN B	
9410 KEY WEST AVENUE			ART UNIT	
ROCKVILLE, MD 20850			PAPER NUMBER	

1646

DATE MAILED: 12/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/078,059

Applicant(s)

RUBEN ET AL.

Examiner

Eileen O'Hara

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 11, 17-19, 22, 23 and 25-120 is/are pending in the application.
- 4a) Of the above claim(s) 1, 11, 17-19, 22 and 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25-120 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1, 11, 17-19, 22, 23 and 25-120 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9/25/03. 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1, 11, 17-19, 22, 23 and 25-120 are pending in the instant application. Claims 2-10, 12-16, 20, 21 and 24 have been canceled and claims 25-120 have been added as requested by Applicant in the Paper filed Sept. 25, 2003.

#### ***Election/Restriction***

2. Applicant's election with traverse of Group III is acknowledged. The traversal is on the ground(s) that restriction remains improper unless it can be shown that the search and examination of multiple groups would entail a "serious burden." Applicants submit that a search of the sequence of the polynucleotides would provide useful information about the polypeptides, and that in many if not most publications where a nucleotide sequence is an open reading frame, the authors also include as a matter of routine the deduced amino acid sequence. Applicants further submit that a search of the polypeptide claims of the invention would provide useful information for the examination of claims directed to antibodies, and that searches of publications directed to polynucleotides and use of those polynucleotides and polypeptides and uses of those polypeptides would clearly be overlapping.

This is not found persuasive because consistent with current patent practice, a serious search burden may be established by (A) separate classification thereof; (B) a separate status in the art when they are classifiable together; (C) a different field of search. These criteria were met in the above restriction. A search for antibodies to a protein would constitute a different search than that of a search for the protein. It is old and well known in the art that antibodies have been generated without having purified protein, and antibodies to one protein may also cross-react with a related protein. Additionally, the nucleic acids, proteins and

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antibodies are classified separately, and as stated in the MPEP § 803, "a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in MPEP § 808.02." Further, a search is directed not only to art which would be anticipatory, but also to art that would render the invention obvious. The fact that some useful information may be obtained in the searches of one group for that of another group, and the fact that there may possibly be overlaps in the searches is not a sufficient basis for holding the restriction to be improper, because the search and examination of one group may not yield all of the necessary information for the other group. Thus, the groups require divergent searches, and to search all inventions would be burdensome.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1, 11, 17-19, 22 and 23 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a nonelected invention.

Claims 25-120 are currently under examination.

#### ***Advisory Information***

3. The claims are interpreted such that the fragment of the antibody must also bind the protein. If Applicants intend otherwise, it is suggested the claims be amended to clarify this.

#### ***Specification***

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Antibodies to cytokine receptor common gamma chain like.

***Claim Objections***

5. Claims 43, 70, 88 and 114 are objected to because of the following informalities:

“CRCGCL” should be written out as “Cytokine Receptor Common Gamma Chain Like”.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 25-120 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 25-120 are indefinite because the claims encompasses an antibody that specifically binds to a polypeptide of SEQ ID NO: 2. The specification does not define what the term “specifically binds” means, and discusses on pages 72-75 that the binding of the antibodies can exclude or include binding to related proteins of various percent identities. The term “specifically binds” is considered indefinite, since the resulting claims do not clearly set forth the metes and bounds of the patent protection desired.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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7.1 Claims 45, 50-53, 90 and 94-97 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification describes a polypeptide sequence consisting of SEQ ID NO: 2, which is shown to have the following activities: inhibiting the differential and/or proliferation of immune cells or stimulating immune cell proliferation. However, the claims as written include antibodies to polypeptides comprising fragments and homologues, encompass antibodies to polypeptides that vary substantially in length and also in amino acid composition. For example, claim 45, sections (e) and (f) are drawn to antibodies obtained from an animal that has been immunized with a protein that **comprises** the amino acid sequence of at least 30 or 50 contiguous amino acid residues of SEQ ID NO: 2, and such a protein can have a significantly different amino acid sequence from that of the protein of SEQ ID NO: 2, and therefore may generate antibodies that would not bind to the protein of SEQ ID NO: 2. The instant disclosure of a single polypeptide, that of SEQ ID NO: 2, does not adequately support the scope of the claimed genus, which encompasses a substantial variety of subgenera. A genus claim may be supported by a representative number of species as set forth in *Regents of the University of California v Eli Lilly & Co*, 119F3d 1559, 1569, 43 USPQ2d 1398, 1406 (Fed. Cir. 1997), which states:

“To fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that “the inventor invented the claimed invention”. Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (1997); In re Gosteli, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1980) (“[T]he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.”) Thus, an applicant complies with the

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written description requirement “by describing the invention, with all its claimed limitations, not that which makes it obvious,” and by using “such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention.” Lockwood, 107 F.3d 1565, 1572, 41 USPQ2d at 1966.

An adequate written description of a DNA, such as the cDNA of the recombinant plasmids and microorganisms of the ‘525 patent, “requires a precise definition, such as by structure, formula, chemical name, or physical properties,” not a mere wish or plan for obtaining the claimed chemical invention. Fiers v. Revel, 984 F.2d 1164, 1171, 25 USPQ2d 1601, 1606 (Fed. Cir. 1993). Accordingly, “an adequate written description of a DNA requires more than a mere statement that it is part of the invention and reference to a potential method for isolating it; what is required is a description of the DNA itself.” Id at 1170, 25 USPQ2d at 1606.”

A description of a genus of cDNAs may be achieved by means of a recitation of a representative number of cDNAs, defined by nucleotide sequence, falling within the scope of the genus, or of a recitation of structural features common to the genus, which features constitute a substantial portion of the genus. The instant specification discloses, however, a single isolated polypeptide sequence SEQ ID NO: 2, and antibodies to that protein. Given the fact that the specification fails to provide objective evidence that the additional sequences are indeed species of the claimed genus it cannot be established that a representative number of species have been disclosed to support the genus claim. The instantly claimed genus is not so limited and the prior art does not provide compensatory structural or correlative teachings to enable one of skill to identify the antibodies encompassed.

7.2 Claims 71-114 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with

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which it is most nearly connected, to make and/or use the invention. Applicants referral to the deposit of cDNA clone HTAEK53 as ATCC number 209641 and 209691 on page 3 of the specification is an insufficient assurance that all of the conditions of 37 CFR sections 1.801 through 1.809 have been met. If the deposits were made under the provisions of the Budapest Treaty, filing of an affidavit or declaration by applicants, assignees or a statement by an attorney of record over his or her signature and registration number stating that the deposits have been accepted by an International Depository Authority under the provisions of the Budapest Treaty, that all restrictions upon public access to the deposits will be irrevocably removed upon the grant of a patent on this application and that the deposit will be replaced if viable samples cannot be dispensed by the depository is required. This requirement is necessary when deposits are made under the provisions of the Budapest Treaty as the Treaty leaves these specific matters to the discretion of each State. Additionally, amendment of the specification to recite the date of the deposit, the complete name and address of the depository, and the accession number of the deposited cell line is required.

*Pertinent art*

8. The art considered pertinent to the present application is United States Published Application, US 2002/0173623, which discloses a polypeptide identified as human R $\delta$ 2 (see SEQ ID NO: 4), which is 100% identical to the polypeptide of SEQ ID NO: 2 of the present application. This is not considered prior art, as the priority date of the instant application is before that of US 2002/0173623.



***Conclusion***

9. No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eileen B. O'Hara, whose telephone number is (703) 308-3312. The examiner can normally be reached on Monday through Friday from 10:00 AM to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached at (703) 308-6564.

Official papers Before Final filed by RightFax should be directed to (703) 872-9306.

Official papers After Final filed by RightFax should be directed to (703) 872-9307.

Official papers filed by fax should be directed to (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Eileen B. O'Hara, Ph.D.



Patent Examiner